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08/556,769 11/02/95 EUGELHOFF

13M1/1004

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EXAMINER	
HASTINGS, K	
ART UNIT	PAPER NUMBER

1303
DATE MAILED:

10/04/96

10/04/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 9-19-96 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☒ Notice of References Cited by Examiner, PTO-892.
- ☒ Notice of Draftsman's Patent Drawing Review, PTO-948.
- ☒ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐

Part II SUMMARY OF ACTION

1. ☒ Claims 1-31 are pending in the application.

Of the above, claims — are withdrawn from consideration.

2. ☐ Claims — have been cancelled.

3. ☐ Claims — are allowed.

4. ☒ Claims 1-31 are rejected.

5. ☐ Claims — are objected to.

6. ☐ Claims — are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on —. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on —, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed —, has been ☐ approved; ☐ disapproved (see explanation).

12. ☒ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☒ been filed in parent application, serial no. 055919; filed on 4/29/93

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

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Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, 29, 30 line 8 "of a substantial length" is relative and thus indefinite; how long/short may be length be to be substantial/not substantial? This phrase must be deleted. Furthermore the original specification teaches "without a single wire predrainage zone" The addition of "at least without... of any substantial length is deemed to be new matter not supported by the original specification, thus WO 91/02842 is available as prior art against these claims.

Claim 1 it is unclear which strips first and second means for collecting water is meant for, all of the first and second drainage strips are implied in the current language, yet that is not clear nor supported by the specification. It appears that --second-- should be inserted before "drainage" on line 33 and line 36 of claim 1 to be clear and consistent with the specification.

Claim 10 line 2 delete the quotation marks as unnecessary.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 and claims 1, 2 of U.S. Patent No. 5,389,206 and 5,500,091, respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are merely of slightly differing scope from those of the two patents; for example it would have been prima facie obvious to eliminate the stationary feature of claim 1, of '206 patent or to use first and second means for collecting water as claimed in claim 1 of this case as such is conventional and well known to the artisan and in any event this feature was disclosed in both '206 and '091 specification and could have been claimed in those cases.

Claims 1-31 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as

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obvious over WO 91/02842 or under 35 USC 103 as obvious over WO 842 in view of Halme et al.

Each independent claim contains a limitation not disclosed in the parent specification re: "neither wise belt defining a single wire predrainage zone of a substantial length" (emphasis provided) Applicants are therefore only entitled to the instant filing date of Nov 25, 1995 for these claims and WO '842 is available as prior art. See In re Van Langehoven 173 USPQ 426.

WO 842 teaches everything in these claims except there is no single wire predrainage zone which is encompassed by the language. However the language also encompasses that there can be a predrainage zone and if necessary Halme et al is cited as teaching the alternative of a gap former with no single wire predrainage zone or having such a zone. Thus it would have been prima facie obvious to have such a zone in WO '842 as a known alternative configuration in this art.

Claims 1-4, 7-28 and 31 are rejected under 35 U.S.C. § 103 as being unpatentable over Tissari or Koski in view of DE '133, further in view of Nyman or WO 86/04368 or Nevalainen et al.

Tissari, especially Fig 6, shows almost every feature of claim 1 except it does not specify that strips 44 are resiliently supported or first/second means for collecting water;

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Likewise Koski shows almost every feature of claim 1 except resilient support of strips 17 or 37 (note one can view Koski either roll 21 or roll 15 as curved drainage element and then strips 17 or 37 respectively as strips in same belt loop as curved drainage element) and first and second means for collecting water.

However the artisan is well aware of the option and advantages of resiliently supported strips, means for collecting water, and vacuum means (claim 9) as evidenced by DE '133. Thus it would have been prima facie obvious to resiliently support at least one or more of the appropriate strips in either reference for the known advantages of same. Furthermore to use vacuum means (claim 9) for the well known advantage of increased dewatering is also prima facie obvious to the artisan and is ~~ex~~mply suggested by both DE '133 and Tissari or Koski when viewed as a whole; see for example Tissari col 7 line 59 to col 8 line 2. Note DE '133 Fig 3 can have suction in both the upper and/or lower box to aid dewatering.

In addition, when using vacuum for the second upper drainage strips especially, it is well known and conventional to use a separate collecting means for the first strip versus all the other strips - see for example Nyman's first slot for first strip

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versus subsequent collecting means, WO 86/04368 also depicts this feature as well as Nevalainen et al. Also to have individual water collectors for each strip is suggested by Tissari Fig 5 element 40.

Furthermore, even without a reference, providing means to collect water stripped off by dewatering elements is conventional in this art, and absent evidence of unexpected results or criticality, to optimize how many and where the means for collecting water are located would have been prima facie obvious.

Claims 5 and 6 would be allowable if rewritten to overcome ^{and the obvious type patenting rejection} the rejection under 35 U.S.C. 112, and to include all of the limitations of the base claim and any intervening claims.

(Claims 29, 30 are allowable, if a terminal disclaimer is filed to overcome obv type double patenting rejection)
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. Hastings whose telephone number is (703) 308-0470. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Don Czaja, can be reached on (703) 308-3852. The fax phone number for this Group is (703) 305-7115.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0651.

Exr Hastings/krb
October 3, 1996

Exr Hastings
HASTINGS
EXAMINER
ART UNIT 133

10-4-96